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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,031	07/25/2003	Gopala Pillai	KMI010USU	3706
45180 7590 07/21/2008 GRIMES & BATTERSBY, LLP 488 MAIN AVENUE, THIRD FLOOR NORWALK, CT 06851				
EXAMINER				
WILLIAMS, JAMILA O				
ART UNIT		PAPER NUMBER		
3725				
MAIL DATE		DELIVERY MODE		
07/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/627,031

**Applicant(s)**

PILLAI ET AL.

**Examiner**

JAMILA WILLIAMS

**Art Unit**

3725

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11, 13-17 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-17 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Prosecution Application***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11-2-2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-11,13-17,19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for "a circular depression centered in said body planar surface, said depression having a circular sidewall and a flat floor wherein said floor is parallel to said body planar surface...a circular protrusion centered in said appendage planar surface, said protrusion having a circular sidewall and a flat roof wherein said roof is

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parallel to said appendage planar surface", these limitations therefore constitute new matter.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 13-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,980,260 to Caputi in view of U.S. Patent No. 5,380,233 to Numoto and U.S. Patent No. 4,186,515 to Ogawa.

Caputi discloses the claimed invention except for having an arcuate shoulder ridge extending partially around the planar surfaces of the body exposing a portion of the planar surfaces having sufficient width to allow the appendages to be slid therein; a means for limiting the rotational and linear movement of the appendage relative to the body comprised of a pair of complementary ribbed elements disposed on the planar surfaces; one set of ribbed elements are comprised of beveled raised elements and the other set of ribbed elements are comprised of beveled recessed elements that engage each other when the appendage is attached to the body; the magnetic elements are disposed within the planar surfaces of the body and appendage; the ribs are approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm; and the planar surfaces disposed on the body all being practically identical in size and shape.

However, Ogawa teaches a toy animal (2) comprising a body (4) having an arcuate shoulder ridge (see figs.1, 4, defined by the arcuate shoulder ridge substantially perpendicular to the planar surface, that partially surrounds the front legs of the horse located just below the bores defined by reference numeral 20) extending partially around the planar surfaces of the body exposing a portion of the planar surfaces having sufficient width to allow the appendages to be slid therein (see figs.1, 4). The ridge conceals attachment of appendage to body and limit movement both rotationally and linearly (rotational and linear movement would be limited by the arcuate contour of the ridge of Ogawa).

Furthermore, Numoto teaches an attachment means for attaching appendages to a figure comprising an arcuate ridge (see fig. 5, defined by reference numeral 52), and that limit the rotational and linear movement of the appendage relative to the body, and is comprised of a pair of complementary ribbed elements (56), wherein one set of ribbed elements are comprised of beveled raised elements (57) and the other set of ribbed elements are comprised of beveled recessed elements (53) that engage each other when the appendage is attached to the body (see figs. 5, 6); magnetic elements (60, 63) that are disposed within the planar surfaces of the body and the elements configured to be attachable to the body (see figs. 5, 6). Numoto also discloses a circular depression in the body planar surface (figure 5 opening for arm) centered in the body planar surface, the depression having a circular sidewall and a flat floor (the floor formed by element 63 which is also part of the body), the appendage (arm of figure 6) having a circular protrusion centered in the appendage planar surface and having a circular

sidewall (surface around periphery of element 60) and a flat roof (face of element 60) parallel to the appendage planar surface.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the toy of Caputi, in view of Numoto and Ogawa, such that it would provide the toy of Caputi with the concept of the aforementioned limitations for the purpose of providing a more lifelike appearance to the toy animal, and a stronger and more secure attachment structure for the appendages and body of the toy.

Additionally, it would have been an obvious matter of design choice to modify the size of the planar surfaces disposed on the body and the ribs to be approximately 0.75mm wide and 0.75mm deep and have a diameter of approximately 9.75mm, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). It would have also been an obvious matter of design choice to make the planar surfaces disposed on the body of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47. Furthermore, there is no criticality for these limitations anywhere in the specification of the present invention (see pgs. 13 and 14, lines 24-26 and 1, respectively); and given that the Caputi reference, as modified, discloses all of the claimed structural limitations of the above claims, it is

therefore assumed to be capable of performing all of the claimed functions of the above claims.

### ***Response to Arguments***

Applicant's arguments filed on 11-2-2007 have been fully considered but they are not persuasive.

The drawing and specification objections have been overcome by amendment.

The amendments to the claims have introduced new matter that was not originally disclosed. The art rejections to Caputi, Numoto and Ogawa are maintained. Caputi discloses a toy with magnetically attached appendages. The examiner maintains that Ogawa provides a teaching for the circular depressions and protrusions introduced in the amendment. Numoto is still provided to clearly show an arcuate ridge.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./  
Examiner, Art Unit 3725

/Derris H Banks/  
Supervisory Patent Examiner, Art  
Unit 3725